

Due Date: July 7, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
)
Inventor: Neelakantan Sundaresan) Examiner: C. Nguyen
)
Serial #: 09/323,605) Group Art Unit: 3625
)
Filed: June 1, 1999) Appeal No.: _____
Title: METHOD AND SYSTEM FOR)
CO-BROWSING IN ELECTRONIC COMMERCE)

#15
Bury

REPLY BRIEF OF APPELLANT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR §1.192, Appellant hereby submits the Appellant's Reply Brief (in triplicate) in connection with the Appeal from the final rejection in the above-identified application as set forth in the Office Action dated September 27, 2002.

I. INCORPORATION OF APPEAL BRIEF

Appellant incorporates by reference the entire contents of Appellant's Brief on Appeal dated February 21, 2003. The remarks presented below are limited to those offered in response to the Examiner's Answer dated May 7, 2003.

II. ARGUMENTS

A. A Prima Facie Case of Obviousness Has Not Been Made

In response to Appellant's arguments, the Examiner continues to provide vague indications (without identification of specific page and line numbers) of references that allegedly meet each of elements (a) through (g) of claim 1 (see Examiner's Answer at section (10)(A)-(D)). To make out a *prima facie* case for obviousness, the Examiner must show that the prior art teaches or suggests all limitations of the claim. In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In *re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In the present case, the Examiner has not made out a *prima facie* case of obviousness because it has not been shown that each element of the claims is taught or suggested in the prior art.

Specifically, the Examiner has not shown that the prior art teaches or suggests the following limitations of Appellant's claims:

- providing co-browsing by users shopping over a computer network (preamble of claim 1);
- identifying a common browsing pattern of a first user and of a second user of a network site offering items for sale (see claim 1(c));
- **informing the users of the common browsing pattern** (see claim 1(d));
- providing to the first and second users of the network site **capability to inform the network site of interest in co-browsing with the other user** (see claim 1(e) and (f));
- providing a capability for communication between the interested first and second users **while they continue to shop** on the network site (claim 1(g)).

B. The Independent Claims are Patentable Over the Prior Art

With regard to element (c) of claim 1, directed to "identifying a common browsing pattern of the first and second users", the Examiner argues in section (10)(A) of the Examiner's Answer that Bull et al. "obviously suggest an inherent action of 'identifying'." This allegedly obvious suggestion is purported to be found in Bull in the following: "browsing patterns of the user are analyzed and these patterns update profiles". While Bull may teach analyzing user browsing patterns, Bull does

not teach identifying common browsing patterns of a first and second user. Because the objective in Bull differs from that of the claimed invention, as Bull analyses browsing patterns of a particular user to tailor a session to that same individual user, there is no suggestion in Bull to modify its teachings to arrive at element (c) of Appellant's claim 1. The mere existence of data capable of use for the claimed element does not serve as an inherent teaching of that element. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In section 10(E) of the Examiner's Answer, it is asserted that claim limitations 1(c) and 1(d) are suggested by Sonnenreich et al., which organizes access by users through a central server with common screen buttons to readily identify similar interest users on a single screen display. Sonnenreich, however, teaches a system for networking students who have enrolled in an Internet-based educational program. The system of Sonnenreich maintains a database containing a personal information and identification directory on all the users that includes information on the users' selected informational topics of interest. Sonnenreich relies on information in a pre-existing database to identify topics of common interest amongst users. This is not the same as identifying common browsing patterns and informing users of their common browsing patterns while the continue to shop on the network site.

The Examiner cites Bull as teaching element (d), informing the users of the common browsing pattern, because Bull teaches "browsing patterns of the user are analyzed and these patterns update profiles". The updating of user profiles as taught in Bull, however, is not the same as informing the users of a common browsing pattern. Bull is directed at analysis of user browsing patterns to update profiles for the purpose of tailoring advertisements and coupons to individual user profiles (see, e.g., lines column 8, lines 23-30). This does not teach or suggest providing information about user browsing patterns to the other concurrent users. Moreover, Bull teaches updating the user profile with data relating to browsing patterns "so that when they next use the information aggregation and synthesization system, the nominated searches will be customized to their individual desires" (column 4, lines 30-33). This statement makes it clear that Bull does not contemplate or suggest using the data regarding browsing patterns to inform other users who are shopping at the network site, let alone to do so "while they continue to shop on the network site".

In addition, nor a single reference is cited as teaching elements (e) and (f) of claim 1, which relate to providing to the first and second users of the network site capability to inform the network site of interest in co-browsing with the other user. To meet the objective of providing co-browsing by users shopping over a computer network, the users must be given the opportunity to inform the network site of this interest in co-browsing so that they can make use of it. At the very least, the obviousness rejection cannot stand given that the Examiner has not identified a prior art reference teaching elements (e) and (f) of claim 1.

Likewise, element (g) of claim 1 is not fully met by the cited references. This element is directed to "providing a capability for communication between the interested first and second users while they continue to shop on the network site." The Examiner cites Fernandes and Sonnenreich as allegedly teaching this element. Fernandes is cited as teaching users who communicate in real-time using a computer keyboard and browsing on the world wide web while having a conversation. This falls short of providing capability for communication between interested users ("interested users" referring back to users who have indicated their interest in co-browsing after being informed by the network site of others showing a common browsing pattern) while they continue to shop on the network site. Fernandes does not teach providing this capability to interested users while they continue to shop on the network site. Instead, Fernandes teaches communication in the context of a meeting in the business world or via on-line chat rooms.

Sonnenreich is even further removed from the context of shopping on a network site and from co-browsing initiated by the network site on the basis of identified common browsing patterns. Sonnenreich is directed to an Internet-based distance learning system and provides for communication between clients who have first elected to become members of a user group based on pre-selected information topics. Sonnenreich teaches away from Appellant's invention because it suggests that real-time intercommunication amongst users must be set up within a group of users who have first elected to become members of a group, rather than having the opportunity for communication initiated by the network site based on monitoring of the users' common browsing patterns.

Thus, Appellant submits that independent claims 1, 11, and 21 are allowable over the cited references.

C. The Dependent Claims Are Patentable Over The Prior Art

With regard to dependent claims 2, 12 and 22, these claims recite further providing the users with a window for interfacing with the network site, wherein the window comprises a first pane that displays information relating to items for sale and a second pane that displays content of the communication between the first and second user. Section (10)(C) of the Examiner's Answer argues that the provision of a window with first and second panes has been a capability of MS Windows environment, is suggested in the Hodges reference, and is somehow inferentially taught by Fernandes through the mention of newsgroups because of the custom of copying an original article into the body of a reply. Appellant, while not entirely clear on the intended argument based on Fernandes (or on MS Windows), maintains that copying an article into the body of a reply does not teach a window comprising first and second panes, the first pane relating to items for sale and the second pane displaying content of communications between first and second users.

Hodges teaches a shared-data mode in which the user and a realtor can view the same records simultaneously, while also talking on the phone. Hodges does not teach a second pane that displays content of the communication between the first and second user. In Hodges, the content of the communication is shared orally via the telephone and is not displayed in a window.

With regard to the remaining dependent claims, no references are cited as disclosing these features. Instead, it is alleged that "it would be obvious for one with ordinary skill in the art to provide such information within means of available communications". Appellant respectfully notes that this type of conclusory statement regarding the general knowledge in the art is not sufficient grounds for an obviousness rejection. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002).

Thus, the Appellant submits that dependent claims 2-10, 12-20, and 22-30 are also allowable over the cited references.

D. Conclusion

In light of the above arguments, Appellant respectfully submits that the cited references do not anticipate nor render obvious the claimed invention. More specifically, Appellant's claims recite novel physical features which patentably distinguish over any and all references under 35 U.S.C. §§ 102 and 103. As a result, a decision by the Board of Patent Appeals and Interferences reversing the Examiner and directing allowance of the pending claims in the subject application is respectfully solicited.

Respectfully submitted,

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GHG/KSC/amb

G&C 30879.73-US-01

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Serial No.:	09/323,605
Filed:	June 1, 1999
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Our Ref. No.:	AM999007 (ADM)

Please charge all fees to Deposit Account No. 09-0441 of IBM Corporation, the assignee of the present application.

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Neelakantan Sundaresan Examiner: C. Nguyen
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Commissioner for Patents
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Dear Sir:

We are transmitting herewith the attached:

- ☒ Transmittal sheet, in duplicate, containing a Certificate of Mailing or Transmission under 37 CFR 1.8.
☒ Reply Brief of Appellant (in triplicate).

CLAIMS PRESENT

Claims Remaining:	Highest Number Previously Paid For:	Number Extra	Rate	Fee
Total Claims				
			x \$18.00	= \$
Independent Claims				
			x \$84.00	= \$
MULTIPLE DEPENDENT CLAIM FEE				\$0.00
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Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate.

Please charge all fees to Deposit Account No. 09-0441 of IBM Corporation, the assignee of the present application. A duplicate of this paper is enclosed.

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